



Attorney Docket # 4167-242

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Jakobsson, et al.

Serial No.: 09/538,663

Filed: March 30, 2000

For: Methods of Protecting Against Spam Electronic Mail

RECEIVED

JUL 1 - 2004

GROUP 3600

DECLARATION UNDER 37 C.F.R. §1.131

I, Bjorn Marcus Jakobsson, declare as follows:

1. This declaration is submitted in support of U.S. Patent Application Serial Number 09/538,663 and, specifically to establish conception of the invention in the United States prior to the March 10, 2000 filing date of U.S. Patent No. 6,691,156 ("Drummond"), the reference cited by the Examiner in rejecting the claims under 35 U.S.C. §102(e), and to establish reasonable diligence in the period between the conception and filing of the subject patent application.

2. The subject patent application was filed on March 30, 2000, which is the constructive reduction to practice date of the subject invention.

3. From the period prior to March 10, 2000 until the application was filed, applicants were, in conjunction with their attorneys, diligently preparing the subject application for filing in the United States Patent and Trademark Office.

4. The invention which is the subject of this patent application was conceived by me prior to April 2, 1999. On or before April 2, 1999, a full description of the invention in the form of a manuscript was submitted to my department supervisor, A. Silberschatz, at Lucent Technologies for consideration as the subject of possible patent protection. I created the manuscript in preparation for a proposed talk to be held on September 20, 1999 at Communications and Multimedia Security in Leuven, Belgium. A copy of the manuscript is attached hereto as Exhibit A.

5. On April 2, 1999, A. Silberschatz summarized my disclosure in a letter to Jeffrey Weinick of the Lucent Technologies patent review department. A copy of A. Silberschatz' letter to Jeffrey Weinick, bearing the date of April 2, 1999, is attached hereto as Exhibit B.

6. Copies of A. Silberschatz' April 2, 1999 letter were also provided to me and, upon their receipt, I forwarded the above-referenced manuscript to Jeffrey Weinick for his review, together with a "Request for Approval of Manuscript" dated April 7, 1999. A copy of the "Request for Approval of Manuscript" is attached hereto as Exhibit C.

7. The manuscript of Exhibit A discloses all of the essential subject matter of the present application upon which the claims of the application are based.

8. In the Spring of 1999, the invention was in the patent review process within Lucent, which typically receives from its employees approximately 60 to 70 submissions of inventions per month. The subject invention was assigned a submission number and handled in turn.

9. In May of 1999, Lucent's file relating to my invention and containing the disclosure of Exhibit A was submitted to Eli Weiss, Corporate Counsel for the Intellectual Property Law Department of Lucent Technologies, who sent the file (now assigned Lucent Technologies IDS ("invention disclosure submission") number 118626 to Lucent Technologies outside patent counsel, the firm of Cohen, Pontani, Lieberman and Pavane, for preparation and filing of the subject application. A copy of the transmittal letter forwarding the disclosure to Cohen, Pontani, Lieberman and Pavane is attached hereto as Exhibit D.

10. Shortly after the disclosure file was sent to Cohen, Pontani, Lieberman and Pavane for preparation of a patent application on my invention, we were contacted by Jeffrey Navon, an attorney at Cohen, Pontani, Lieberman and Pavane, to discuss the invention so that a patent application could be prepared. Mr. Navon provided me with a draft patent application on October 15, 1999, and requested that I review it and provide him with comments. A copy of Mr. Navon's facsimile transmission sheet requesting my review of the draft application is attached hereto as Exhibit E.

11. I reviewed the first draft of the patent application and provided Mr. Navon with our comments during the first week of December 1999. In an email dated December 7, 1999, Mr. Navon indicated that he received my comments and would send me a revised draft later in the week. A copy of Mr. Navon's email of December 7, 1999 is attached hereto as Exhibit F.

12. In a letter dated February 9, 2000, Mr. Weinick established a new, non-extendible filing date of March 30, 2000 for my patent application. Mr. Weinick's letter was addressed to Lance Lieberman, a partner at Cohen Pontani, Lieberman and Pavane who is responsible for managing Lucent cases. A copy of Mr. Weinick's letter is attached hereto as Exhibit G.

13. On March 10, 2000, I completed my review of the revised patent application draft and emailed my comments to Mr. Navon. A copy of our email of March 10, 2000 is attached hereto as Exhibit H.

14. On March 22, 2000, I completed my review of a further revised patent application draft and emailed my comments to Mr. Navon. A copy of my email of March 22, 2000 is attached hereto as Exhibit I.

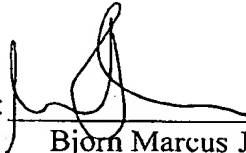
15. Mr. Navon incorporated my comments into a finalized draft which was filed with the United States Patent and Trademark Office on March 30, 2000. In a letter dated April 3, 2000, Mr. Lieberman indicated that the application was filed in unexecuted condition, and forwarded

a Declaration and Assignment to me for signature. A copy of Mr. Lieberman's letter of April 3, 2000 is attached hereto as Exhibit J.

16. As is clear from the foregoing, applicants and those involved in preparing and filing the subject application on applicants' behalf, have exercised reasonable diligence from prior to the March 10, 2000 filing date of the cited Drummond patent (i.e., from April 2, 1999) up to the filing date of this application. Accordingly, the Examiner's rejection under 35 USC 102(e) should be withdrawn.

17. I declare that all statements made herein of my own knowledge are true, that all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful, false statements and the like are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this patent application and any patent resulting therefrom.

Date: Jun 23 '04

By:   
Bjorn Marcus Jakobsson